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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,582	07/09/2003	Eric Raffaele	B-4504DIV 621038-6	1312

7590 02/06/2008

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EXAMINER	
GORTAYO, DANGELINO N	
ART UNIT	PAPER NUMBER
2168	
MAIL DATE	DELIVERY MODE
02/06/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/616,582	RAFFAELE ET AL.	
	Examiner	Art Unit	
	Dangelino N. Gortayo	2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 November 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,12,13,15 and 16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3, 12-13, and 15-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-3, 12-13, and 15-16 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 13 and 15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. For an invention to be statutory, an invention must disclose a "useful, tangible, and concrete result". The claimed invention as a whole must be useful and accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966)); In re Fisher, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); In re Ziegler, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).

Claim 13 recites the limitation "transaction aid comprising program code elements for carrying out a process as claimed in claim 1". The claim fails to produce a

tangible medium to store the program code and carry out the process as claimed in claim 1. Therefore the claim is rendered non-statutory. Proper correction is required.

Independent claim 15 is non-statutory because the claim is directed to software per se. The claim recites the limitation "A transaction aid computer program product having program code elements for carrying out a process as claimed in claim 1", and lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. Nowhere in the specification of the instant application is the computer program product combined with, or includes a tangible storage medium, and there is also no tangible medium mentioned in the specification that the program code is saved in. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material per se.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are non-statutory when claimed as descriptive material per se, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See Diehr, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in Benson were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the program-ming of a general purpose computer.").

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-3, 12-13, and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta et al. (US Patent 7,206,844 B2) in view of Kraenzel et al. (US Patent 6,854,016 B1)

As per claim 1, Gupta teaches "A process for executing a downloadable service with specific access rights to at least one profile file in a user's computer, said computer comprising a web browser communication to the Internet or intranet via a first communication port and socket," (see Abstract, column 5 lines 35-46, column 5 line 56 – column 6 line 27)

said process comprising: arranging a confined run time environment which is assigned a second communication port and socket (Figure 3 reference 320, Figure 4A

and 4B reference 408, 418, 428, column 6 lines 48-67, column 10 lines 32-53, column 10 line 66 – column 11 line 28, column 17 line 41 – column 18 line 13, wherein a webtop server can establish proxy services to satisfy a sandbox security scheme) "and provided with restricted access to at least one profile file; (column 7 lines 16-28, column 12 line 45 – column 13 line 32, wherein a client profile is stored in a local webtop server connected to a client that is accessed by the webtop server)

downloading said service through said second communication port so that it is received by said confined run time environment; (column 6 lines 11-27, column 10 lines 32-53, column 19 lines 24-57, wherein applets and application software is received by a webtop server)

"and executing said service within said confined rum time environment whereby said service is given restricted access to said at least one profile file." (column 16 lines 9-19, column 17 lines 61 – 14, wherein a webtop server installs application software and passes data onto client)

Gupta does not teach profile file that is located on the user's computer;

Kraenzel teaches profile file that is located on the user's computer; (column12 line 66 – column 13 line 35, column 18 lines 32-67, wherein a profile file resides in a client that is accessed when executing downloaded files)

It would have been obvious at the time of the invention for one of ordinary skill in the art to combine Gupta's method of establishing a webtop server connected to a client to execute downloadable services based on profile information with Kraenzel's method of storing profile information on a client computer. This gives the user the benefit of

making the process of transferring and executing downloaded files more secure, since client information resides on the client, and allows for customizability based on profile information on the client. The motivation for doing so would be to provide a level of security and stability when downloading code from remote sources (column 2 lines 7-19)

As per claim 2, Gupta teaches "said confined run time environment is an extended sandbox having restrictive access to said at least one profile file." (column 13 lines 10-25)

As per claim 3, Gupta teaches "the service is downloaded under the form of a set of java code containing class structures packaged within a signed archive file; the service comprising: remote Internet data, a list of requested data that are needed to personalise the service, and code to sort remote Internet data using requested accessible data." (column 13 lines 34-57, column 44-60, column 15 lines 32-53)

As per claim 13, the claim is rejected on the same grounds of claim 1 above. Additionally, Gupta teaches "A transaction aid for assisting a transaction between an user and at least one remote server, said transaction aid comprising program code elements" (column 8 lines 15-23, column 9 lines 27-52)

As per claim 15, the claim is rejected on the same grounds of claim 1 above. Additionally, Gupta teaches "A transaction aid computer program product having program code elements" (column 8 lines 15-23, column 9 lines 27-52)

As per claim 16, Gupta teaches "A process for executing a downloadable service with specific access rights to at least one profile file in a user's computer, said computer comprising a web browser communication to the Internet or intranet via a first communication port and socket," (see Abstract, column 5 lines 35-46, column 5 line 56 – column 6 line 27)

said process comprising: arranging a confined run time environment in said user's computer, said confined run time environment being assigned a second communication port and socket (Figure 3 reference 320, Figure 4A and 4B reference 408, 418, 428, column 6 lines 48-67, column 10 lines 32-53, column 10 line 66 – column 11 line 28, column 17 line 41 – column 18 line 13, wherein a webtop server can establish proxy services to satisfy a sandbox security scheme in conjunction with a client) "and provided with restricted access to at least one profile file that is located on the user's computer;" (column 7 lines 16-28, column 12 line 45 – column 13 line 32, wherein a client profile is stored in a local webtop server connected to a client that is accessed by the webtop server)

"downloading said service through said second communication port so that it is received by said confined run time environment;" (column 6 lines 11-27, column 10 lines 32-53, column 19 lines 24-57, wherein applets and application software is received by a webtop server)

"and executing said service within said confined rum time environment whereby said service is given restricted access to said at least one profile file." (column 16 lines

9-19, column 17 lines 61 – 14, wherein a webtop server installs application software and passes data onto client)

Gupta does not teach a profile file that is located on the user's computer;

Kraenzel teaches a profile file that is located on the user's computer; (column12 line 66 – column 13 line 35, column 18 lines 32-67, wherein a profile file resides in a client that is accessed when executing downloaded files)

It would have been obvious at the time of the invention for one of ordinary skill in the art to combine Gupta's method of establishing a webtop server connected to a client to execute downloadable services based on profile information with Kraenzel's method of storing profile information on a client computer. This gives the user the benefit of making the process of transferring and executing downloaded files more secure, since client information resides on the client, and allows for customizability based on profile information on the client. The motivation for doing so would be to provide a level of security and stability when downloading code from remote sources (column 2 lines 7-19)

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta et al. (US Patent 7,206,844 B2) in view of Kraenzel et al. (US Patent 6,708,221 B1) and further in view of Tan (US Publication 2001/0045451 A1)

As per claim 12, Gupta in combination with Kraenzel discloses the claimed subject matter in claim 1 above. Gupta in combination with Kraenzel does not teach "said downloadable service is an authentication service cooperating with a smart card."

Tan teaches "said downloadable service is an authentication service cooperating with a smart card." (Abstract, paragraph 0010, 0026, 0028, wherein the execution of downloaded service by a client is authentication using a smart card). It would have been obvious at the time of the invention for one of ordinary skill in the art to combine Gupta's and Kraenzel's combined method of remote execution of services from a server based on profile information with Tan's ability to authenticate a user's identity using data in a smart card. This gives the user the benefit of portability when trying to securely access services remotely. The motivation for doing so would be to provide a more robust security system when a user utilizes the Internet to access secure data by improving management of access to web servers (paragraph 0005, 0007).

Response to Arguments

5. Applicant's arguments with respect to the rejection of claims 1-3, 12, 13, 15, and 16 under 35 U.S.S. 102(e) have been considered but are moot in view of the new ground(s) of rejection. An updated search revealed more relevant prior art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jerger et al. (US Patent 6,473,800)

Ims (US Patent 6,542,908 B1)

Dowling (US Patent 7,107,536 B1)

Elgressy et al. (US Patent 7,305,703 B2)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dangelino N. Gortayo whose telephone number is (571)272-7204. The examiner can normally be reached on M-F 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim T. Vo can be reached on (571)272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Dangelino N. Gortayo
Examiner

Tim T. Vo
SPE

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